

REMARKS

Applicant respectfully submits that the present invention is distinguishable over each of the prior art references cited by the Examiner, and in support presents the following arguments. Claims 1-34 are pending, and claims 1-13, and 21-33 are currently withdrawn from examination. Claim 14 has been amended, and claim 34 has been added. In addition to amendments noted below, applicant has rewritten claim 14 so that it no longer depends from withdrawn claim 1. Claim 34 contains all the limitations of previously submitted claim 15, as well as the target fluid comprising a hydrocarbon. Applicant submits that no new matter has been added. Applicant believes that claims 14-20 and 34 are distinguishable over prior art as discussed below, and are in condition for allowance.

Response to 35 U.S.C. § 102

Cited Art WO 98/08919 ("Kalota") Fails to Teach Each and Every Element of the Current Invention

Applicant respectfully traverses the initial rejection of claims 14-15 and 18-20 under 35 U.S.C. § 102(b) by WO 98/08919 filed in the name of Kalota, et al. ("Kalota"). Claim 14 requires that the target fluid comprises a hydrocarbon. Kalota expressly teaches away from using hydrocarbons as Kalota was attempting to create a working fluid that did not require reclaiming or special disposal methods. In fact, Kalota specifically noted the undesirability of using oil, as "[w]orker safety can be an issue with presently employed oil-containing water soluble metal working fluids." (p. 2 lines 21-22). As such, Kalota is missing the element of the target fluid comprising a hydrocarbon. Consequently, Kalota does not teach each and every element of claim 14. As claims 15 and 18-20 depend on claim 14, Applicant respectfully requests the Examiner to

withdraw the rejection based of Kalota and place the aforementioned claim in condition for allowance.

Japanese Patent No. JP62-190297 (JP'297) Fails to Teach Each and Every Element of the Current Invention

Claims 14 and 18-20 are also initially rejected as allegedly being anticipated by JP 62-190297 ("JP 297"). Claim 14 includes that the phosphorus-containing solution is essentially free of alcohol. JP 297 identifies polyhydric alcohol as "an essential component". (Abstract). As such, JP 297 teaches away from and is missing an element of claim 14. Applicant notes that paragraph [0016] discusses the removal of any alcohol in order to create the phosphorus-containing solution by stating that the "intermediate solution is combined with the carrier fluid and the water or other solvent is largely removed to create the phosphorus-containing solution. Preferably the solvent, such as alcohols" Therefore, since the solvent can be alcohol, and essentially all solvent is removed to create the phosphorus-containing solution, the phosphorus-containing solution is essentially free of alcohol. Since JP 297 required alcohol as an essential component, and the current invention is essentially free of alcohol, JP 297 fails to teach each and every element of amended claim 14.

In that claims 18-20 depend from claim 14, they are distinguishable on similar grounds.

Response to 35 U.S.C. § 103

Cited Art WO 98/08919 ("Kalota") and U.S. Patent No. 4,765,917 ("Otaki") Fails to Teach Each and Every Element of the Current Invention

Claims 16-17 are rejected as allegedly being obvious under 35 U.S.C. § 103(a) by Kalota in view of U.S. Patent No. 4,765,917 filed in the name of Otaki et al. ("Otaki"). The Examiner alleges that Kalota discloses all of the limitations of claims 16-17 except the addition of ammonium

acetate. Applicant respectfully traverses this argument as noted above in that Kalota fails to teach that the target fluid comprises a hydrocarbon.

Additionally, Applicant submits that one skilled in the art of conversion surfaces would not look to metal working (Kalota) or hot forging (Otaki) when looking to design a process for creating a conversion surface as the aforementioned processes are in disparate fields. Kalota is most concerned with metal working and providing a non-oil based lubricating fluid useful in cutting, grinding, shaping and other metal working operations. (See Abstract) The purpose is for removal of heat from the work piece and tool, reduction of friction among chips, tool and work piece, removal of metal debris produced by the work. (Page 1, ll, 13-18). Furthermore, compositions in hot forging are not designed to build or modify surfaces but are designed to take away heat and to wet the metal, as well as reduce press load. (See generally Background of the Invention, Otaki). In fact, Otaki teaches the use of a phosphate compound for extreme pressure properties, not for the purpose of building a conversion surface. (Column 2, l. 30). In summary, Otaki teaches an entirely different and disparate process from the current claimed invention. The combination of Kalota and Otaki, even if made, is missing elements of the current invention such as the target fluid comprising a hydrocarbon, in addition to the formation of a phosphate-metal layer.

Claim 17 incorporates the distinguishing characteristics of claim 16 and is distinguishable on the same grounds.

JP 297 and Kalota Fail to Teach Each and Every Element of the Claimed Invention

The Examiner discusses combining JP 297 with Kalota relative to claim 15. As stated above, Kalota fails to teach that the target fluid comprises a hydrocarbon, and JP 297 discloses that alcohol is an essential component of the solution. Therefore, at least two elements of the current

claim are missing from the prior art. As claim 15 incorporates the distinguishing characteristics of claim 14, Applicant respectfully submits that claim 15 is in condition for allowance.

JP 297, Kalota, and Otaki Fail to Teach Each and Every Element of the Claimed Invention

The Examiner discusses combining JP 297 with Kalota and Otaki relative to claims 16-17. As noted previously, JP 297 requires the presence of alcohol and Kalota teaches away from the use of oil. As claims 16 and 17 require the presence of a hydrocarbon and their phosphate-containing solutions are essentially free of alcohol, and Otaki does not teach either element, the combination of JP 297, Kalota and Otaki fails to teach each and every element of the claimed invention. As such, applicant respectfully requests Examiner to place claims 16-17 in condition for allowance.

Applicant Believes Newly Added Claim 34 to be in Condition for Allowance

As noted previously, claim 34 contains all of the limitations of previously submitted claim 15, in addition to requiring the target fluid to comprise a hydrocarbon. Applicant believes the comments above relating to Kalota apply to newly added claim 34, therefore, applicant respectfully requests that the Examiner place newly added claim 34 in condition for allowance as Kalota, JP 297 and Otaki do not teach each and every element of newly added claim 34.

CONCLUSION

In commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any

implied limitations in the claims. Not all of the distinctions between the prior art and Applicant's present invention have been made by Applicant. For the foregoing reasons, Applicant reserves the right to submit additional evidence showing the distinctions between Applicant's invention to be unobvious in view of the prior art.

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention, which render it patentable, being only examples of certain advantageous features and differences that applicant's attorney chooses to mention at this time.

Reconsideration of the application and allowance of all of the claims are respectfully requested. In view of the foregoing Response, applicant respectfully submits that all of the claims are allowable, and Applicant respectfully requests the issuance of a Notice of Allowance. Should further discussion regarding the application be desired by the Examiner, a telephone conference is respectfully requested. I can be reached at (713) 221-3306. Applicant has submitted this response within two (2) months from the date of mailing. As such, applicant believes no fees are required. If applicant is mistaken in this manner, the Commissioner is authorized to charge BRACEWELL & GIULIANI LLP, Deposit Account 50-0259 (27435.002) in the amount of any deficiency.

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Respectfully submitted,



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